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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,865	10/25/2001	Stefan M. Pallazza	S63.2-9720	9976
490	7590	12/02/2004	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			NGUYEN, VI X	
		ART UNIT		PAPER NUMBER
				3731

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/682,865	PALLAZZA, STEFAN M.
	<b>Examiner</b>	<b>Art Unit</b>
	Victor X Nguyen	3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 August 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9, 11, 12, 14, 22, 25, 26, 28, 29 and 64-66 is/are pending in the application.
- 4a) Of the above claim(s) 10, 13, 15, 20, 21, 24, 27 and 30-63 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9, 11, 12, 14, 22, 25, 26, 28, 29 and 64-66 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 64-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 64, lines 4-5, it is not clear what is meant by the phrase "each inflatable member the inflatable members inflatable inward into the channel", applicant needs to clarify what is meant by said phrase.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11-12, 14,22,25-26,28-29 and 64-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Di Caprio et al (U.S. 6,123,712).

Di Caprio et al disclose in Fig. 13, col. 4, lines 56-67 and col. 5, lines 1-35, a device for configuring an inflatable balloon of a balloon catheter assembly having the limitations of claims 1, 5, 14 and 64, including: a body comprises a plurality of inflatable members (134, 144)

defining a channel. Each inflatable members has a balloon contacting portion. In fact, Di Caprio et al disclose in fig. 13 that the inflatable members (134, 144 or 139) are capable of inflating inward into the channel so as to reduce a cross section of the channel which extends perpendicular to a longitudinal axis of the channel. Di Caprio et al disclose a device [so as to reduce a cross section of the channel which extends perpendicular to a longitudinal axis of the channel]. The portion of the claim in brackets above indicates the intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over Di Caprio reference which is capable of being used as claimed if one desires to do so.

As to claims 2-6, 11-12, 22 and 65-66, Di Caprio et al disclose the device comprises at least three inflatable members (fig. 13). The inflatable members are tubular and has a circular cross section. The device further has a rigid tube (135). The tube has a first end with a first opening and a second end with a second opening that has a passage therethrough; and where the plurality of inflatable members are disposed in one spiral about the channel (figs. 14-16), where the balloon contacting portion is made of a compliant material and non-compliant materials such as latex, PET, Polyethylene or nylon (see col. 7, lines 48-67).

As to claims 7-9, Di Caprio et al disclose the device further comprises first end cap and second end caps. The segment of item 135 can be characterized as the first end cap that has the first opening and further to the right side of item 140 in fig. 13 can be characterized as the second end cap disposed at the second end of the tube.

As to claims 25-26 and 28-29, Di Caprio et al disclose in Fig. 13, col. 4, lines 56-67 and col. 5, lines 1-35, a method for configuring an inflatable balloon of a balloon catheter assembly

having the limitations of claims 25-26 and 28-29, including: a body comprises a plurality of inflatable members (134, 144) defining a channel. Each inflatable members has a balloon contacting portion. In fact, Di Caprio et al disclose in fig. 13 that the inflatable members (134, 144 or 139) are capable of inflating inward into the channel so as to reduce a cross section of the channel which extends perpendicular to a longitudinal axis of the channel.

***Response to Arguments***

3. Applicant's arguments with respect to claim 1 have been considered but they are not persuasive. With respect to claim 1, the examiner disagrees with applicant's remarks that the Di Caprio reference fails to disclose that the inflatable members are inflatable inward into the channel so as to reduce in area a cross-section of the channel which extends perpendicular to a longitudinal axis of the channel. As the examiner has pointed out above, the inflatable members (134, 144 or 139) are capable of inflating inward into the channel so as to reduce a cross section of the channel which extends perpendicular to a longitudinal axis of the channel. Di Caprio et al disclose a device [so as to reduce a cross section of the channel which extends perpendicular to a longitudinal axis of the channel]. The portion of the claim in brackets above indicates the intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over Di Caprio reference which is capable of being used as claimed if one desires to do so. Therefore, claim 1 of the invention is not defined over the Di Caprio reference.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M.).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn VN  
11/26/2004



JULIAN W. WOO  
PRIMARY EXAMINER